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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/666,368 | 09/19/2003 | Lilavati Patel | LOREAL 3.0-042 | 8946 |

530 7590 02/08/2006

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

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| EXAMINER |
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DOAN, ROBYN KIEU

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| ART UNIT | PAPER NUMBER |
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3732

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/666,368

Applicant(s)

PATEL ET AL.

Examiner

Robyn Doan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 19 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>12/27/04;08/15/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ounanian (WO/92/19215).

With regard to claims 1-2, Ounanian discloses a method of waterproofing eyelashes comprising steps of applying a waterproof mascara composition to the eyelashes over a coat of conventional mascara (page 1, lines 23-29; page 2, lines 19-22 and page 3, lines 19-23 and 26-33). Since Ounanian shows that the conventional mascara is not waterproof mascara, therefore, it is held to be inherently washable.

Alternatively, it would have been an obvious matter of design choice to modify the conventional mascara to be washable, since it was known in the art that

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conventional mascara is washable with soap and water or with mineral oil, i.e. make up remover. In regard to claim 3, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to apply mascara composition over the false lashes as it is well known to apply mascara to real or false eyelashes.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Avon Products Inc. "Avon Lash Raincoat Waterproof Coating for Mascara- Clear".

With regard to claims 1 and 2, Avon Products Inc. discloses a waterproof coating being applied to eyelashes after applying washable (non-waterproof) mascara (lines 3-5). It is noted that the waterproof coating is considered as a waterproof mascara composition as claimed, since the waterproof coating is applied to the eyelashes.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Avon Products Inc.

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With regard to claim 3, Avon Products Inc. shows waterproof mascara coating being applied on top of the washable (non-waterproof) mascara to the user's eyelashes. Avon Products Inc. fails to show the eyelashes being false lashes, however, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to apply mascara composition over the false lashes as it is well known to apply mascara to real or false eyelashes.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ounanian.

With regard to claim 3, Ounanian shows waterproof mascara coating being applied on top of the washable mascara to the user's eyelashes. Ounanina fails to show the eyelashes being false lashes, however, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to apply mascara composition over the false lashes as it is well known to apply mascara to real or false eyelashes.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ounanian or Avon Products Inc. in view of Cannell et al '389 (IDS cited reference).

With regard to claim 4, Ounanian or Avon Products Inc. discloses a method of applying the washable, waterproof mascara compositions to the eyelashes as discussed above, however, Ounanian or Avon Products Inc. fails to show either or both of the washable and waterproof mascara compositions having a lecithin, an amphoteric

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surfactant and a nonionic surfactant. Cannell et al '389 discloses a mascara composition (col. 3, lines 40-50) having an amphoteric surfactant, a nonionic surfactant (col. 3, lines 36-39) and a lecithin (col. 4, lines 22-34). It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the amphoteric surfactant, nonionic surfactant and the lecithin as taught by Cannell et al into either or both washable and waterproof mascara compositions of Ounanian or Avon Products Inc. for allowing the water-insoluble ingredient to be incorporated into the aqueous solution.

Claims 5-10, 13, 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pettengill (U.S. Pat. # 5,052,839) in view of Ounanian or Avon Products Inc.

With regard to claims 5 and 13, Pentingill discloses a mascara system (fig. 1) comprising a first and second reservoirs (11, col. 2, line 6) for allowing each reservoir to contain a different type of mascara (col. 2, lines 11-12, lines 29-33), at least one applicator (fig. 1) having first (13a) and second (13b) applicator members for applying mascara compositions. Pentingill does not disclose the first reservoir containing a washable mascara composition and second reservoir containing a waterproof mascara composition. Ounanian or Avon Products Inc., as discussed above, shows a method of applying a washable mascara composition and a waterproof mascara composition. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the washable mascara composition and the waterproof

mascara composition as taught by Ounanian or Avon Products Inc. into the two reservoirs of Pentingill for the purpose of providing a pleasing cosmetic appearance to the user. In regard to claims 6 and 15, Pentingill also shows the first and second reservoirs being integral with each other (fig. 1, col. 2, lines 6-7). In regard to claims 7 and 16, Pentingill shows the system having two applicators (14a, 14b), wherein the first applicator (14a) having a first applicator member (13a) and the second applicator (14b) having a second applicator member (14b). In regard to claims 8 and 17, Pentingill discloses one applicator (14a) having handle (12) for manipulation by the user and for closing the reservoirs. In regard to claims 9 and 18, Pentingill shows first and second applicator members (13a, b) being brushes (col. 1, line 61). In regard to claims 10 and 19, Pentingill in view of Ounanian or Avon Products Inc. fail to show the first and second applicator members being different. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to construct the first and second applicator members being different, since such modification would involved an obvious matter of design choice in the shape of a known component needed to obtain the desired results.

Claims 11, 14 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pentingill in view of Ounanian or Avon Products Inc. as applied to claims 5 and 13 above, and further in view of Arai (Japanese Pat. # 2000203634A)

With regard to claims 11, 14 and 20, Pentingill in view of Ounanian or Avon Products Inc. disclose a mascara system comprising all the claimed limitations in claims

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5 and 13 as discussed above except for the system being in a form a blister pack (claim 14) and directions for using the washable and waterproof mascara compositions (claims 11, 20). Arai discloses a cosmetic system (figs. 1-2) comprising a blister pack (1) which holds a cosmetic item (A), the system also having information about the system (translated abstract). It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the blister pack as well as the information about the system as taught by Arai into the system of Pentingill in view of Ounanian or Avon Products Inc. in order to provide information about the product as well as advertising the product.

Claims 12 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pentingill in view of Ounanian or Avon Products Inc. as applied to claims 5 and 13 above, and further in view of Cannell et al '389.

With regard to claims 12 and 21, Pentingill in view of Ounanian or Avon Products Inc. disclose a mascara system comprising all the claimed limitations in claims 5 and 13 as discussed above except for either or both washable and waterproof mascara compositions having a lecithin, an amphoteric surfactant and a nonionic surfactant. Cannell et al discloses a mascara composition (col. 3, lines 40-50) having an amphoteric surfactant, a nonionic surfactant (col. 3, lines 36-39) and a lecithin (col. 4, lines 22-34). It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the amphoteric surfactant, nonionic surfactant and the lecithin as taught by Cannell et al into either or both of the washable and

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waterproof mascara compositions of Ounanian or Avon Products Inc. for allowing the water-insoluble ingredient to be incorporated into the aqueous solution.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-21 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 and 22-38 of copending Application No. 10/759,614. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 1-21 of the instant application and claims 1-4 and 22-38 of the copending application lies in the fact that the copending application claims include more elements and thus is more specific. Thus the invention of claims 1-4 and 22-38 of the copending application

is in effect a "species" of the "generic" invention of claims 1-21 of the instant application. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claims 1-21 of the instant application are anticipated by claims 1-4 and 22-38 of the copending application, they are not patentably distinct from claims 1-4 and 22-38.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Clements is cited to show the state of the art with respect to a mascara system having two reservoirs and two applicator members. Brieve et al is cited to show the state of the art with respect to a mascara composition.

The drawings filed 09/19/2003 have been approved by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robyn Doan whose telephone number is (571) 272-4711. The examiner can normally be reached on Mon-Fri 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robyn Doan
Examiner
Art Unit 3732